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MICHAEL E. MARTIN GARDERE WYNNE SEWELL LLP 1601 ELM STREET, SUITE 3000 DALLAS, TX 75201				
EXAMINER				
HIGGINS, GERARD T				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
10/13/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/822,567

Applicant(s)

BURROW ET AL.

Examiner

GERARD T. HIGGINS

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-35, 37-42 and 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-35, 37-42 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on 07/27/2009 has been entered. Currently claims 29-35, 37-42, and 44 are pending and claims 1-28, 36, and 43 are cancelled.

Claim Objections

2. Claims 29, 37, and 38 are objected to because of the following informalities:
 - a. In claim 29, on the sixth line of the claim, the term "a printed image" is objected to because the term "printed image" was previously introduced on the first line of the claim. This objection will be withdrawn if "a" is changed to "the."
 - b. In claim 37, the phrase "the image sheet including image printed" is objected to for grammatical reasons. Please see sections 4 and/or 6 below for how to address this objection.
 - c. In claim 38, the phrase "having an image being comprised of ink printed" on the eighth line of the claim is objected to because the claim already discloses "a printed image" on the first line of the claim. This objection will be withdrawn if the phrase is changed to "having the printed image on said first side of said image sheet, wherein said printed image is comprised of ink."Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 37, 39-42, and 44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regard to claim 37, the Examiner does not find support for broadly claiming that the image sheet is "cut according to predetermined contours" in the specification as originally filed. The Examiner does find support to state that the image sheet is "cut according to contours of the printed image, wherein the printed image is on the first side of the image sheet and said printed image is comprised of ink" as seen from page 3, lines 16-18 and claim 37.

With regard to claim 39, the Examiner does not find support for saying that "said member and said image sheet are formed of the same material." While applicants are supported for claiming that "said member and said image sheet are formed of a plastic material" or that both are formed of polyvinyl chloride, they are not supported for broadly claiming that they may be ***any*** type of identical materials. Applicants have support for the image sheet and the member/cover part to be the same material only in the case of

them being "plastic" or "polyvinyl chloride." They do not have support for them to broadly be the same material.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 29-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 29, the claim contains an improper Markush group, which renders the claim indefinite, i.e. "being a member of a group consisting of...or keyfob." This rejection will be withdrawn if the claim is amended to recite "being a member of the group consisting of...and a keyfob," which is how the claim will be interpreted.

With regard to claim 37, the claim contains an improper Markush group, which renders the claim indefinite, i.e. "being a member of a group consisting of...or keyfob." This rejection will be withdrawn if the claim is amended to recite "being a member of the group consisting of...and a keyfob," which is how the claim will be interpreted.

With regard to claim 37, applicants are attempting to claim that image sheet is "being **welded** on said second side to said member" and also that the RF energy serves to "**adhere** said image sheet to said member." A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the

explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 37 recites the broad recitation "adhere," and the claim also recites "welded" which is the narrower statement of the range/limitation. Given the fact that applicants see a distinct difference between the words adhere and weld (see Remarks page 11), this provided additional impetus for the Examiner to set forth this rejection; furthermore, for purposes of examination the Examiner will treat the broader limitation adhere.

With further regard to claim 37, the term "predetermined contours" renders the claim indefinite. It is unclear to when predetermined is referring in relation to the time frame of the invention. Perhaps applicants meant "cut according to contours of the printed image, wherein the printed image is on the first side of the image sheet and said printed image is comprised of ink," which is how the claim will be interpreted.

With regard to claim 38, the claim contains an improper Markush group, which renders the claim indefinite, i.e. "being a member of a group consisting of...or keyfob."

This rejection will be withdrawn if the claim is amended to recite "being a member of the group consisting of...and a keyfob," which is how the claim will be interpreted.

Claim 38 recites the limitation "said member" in the ninth, eleventh, and twelfth lines of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if "said member" is changed to "said cover part," which is how the limitations will be interpreted.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

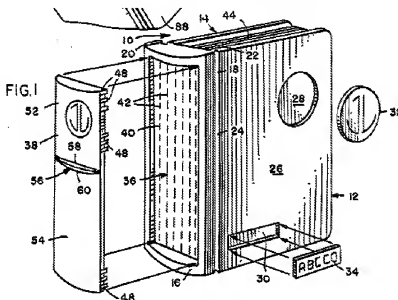
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 29-31 and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello (4,294,469) as evidenced by Miyamoto et al. (4,460,637).

The Examiner notes various product-by-process limitations in applicants' claims, including that the "image sheet being bonded...to said member by pressing said member to adhere said image sheet" (claim 29), that RF energy is used to adhere/weld said image sheet to said member (claims 31 and 37), and that there is an "image sheet...cut according to predetermined contours" (claim 37). It has been held that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-

process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." Please see MPEP 2112 and *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Any article that has the resulting article limitations will be held to anticipate/render obvious applicants' claimed article.

With regard to claims 29, 37, and 38, Errichiello disclose the article of Figure 1.



The article is a book binder 10, which reads on applicants' article being a binder that is comprised of a front cover panel 12, which reads on applicants' cover part or member (col. 3, lines 15-25). The front cover panel is deemed to be flexible and indentable because it is comprised of thermoplastic polymers, which will intrinsically be flexible and indentable. With regard to the term "indentable," there is no indication in applicants' claims at what temperature and pressure condition that applicants' cover part is to be "indentable," and therefore the Examiner deems the cover part indentable because as a

thermoplastic polymer it is inherently indentable, e.g. above its glass transition temperature. It is also noted that there are living hinges **18** and **20** at which there is flexing, which shows the cover part or member to be flexible as claimed (col. 3, lines 26-33). There are inserts **32** and **34**, which read on applicants' image sheet with a printed image (col. 3, line 38) of a first side thereof (col. 3, lines 34-66). These inserts are intrinsically flexible because they can be embossed (col. 3, lines 53-56). The inserts are bound to the front cover panel at the side opposite the indicia. The front cover panel has shallow cavities **28** and **30**, which read on applicants' indentation in a surface of said member. The inserts are bound to the front cover panel by various methods, including gluing, which reads on applicants' claimed adhering, heat-sealed, which reads on applicants' claimed welding, or press-fitted (col. 2, lines 2-27); however, Errichiello does not explicitly state that the indentation in the surface of the member has "a depth at least as great as the thickness of said image sheet" or that the printed image is formed from ink.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the indentations in said cover part/member any depth, including at least as great as the thickness of said image sheet, in order to arrive at a book binder that had a cover panel that was smooth while still maintaining structural stability of the cover panel.

With regard to a printed image being comprised of ink, the Examiner notes again that Errichiello disclose an image sheet with a printed image (col. 3, line 38). The Examiner takes official notice that printing of inks is known in the art. This is evidenced

by Miyamoto et al. where they teach that printing with ink is well-known (col. 1, lines 12-29).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the printing of Errichiello include inks. The printing of ink is ubiquitous in the art for the making of images; furthermore, the results of such a usage of ink would be predictable to one having ordinary skill.

With regard to claims 30, 39, and 40, Errichiello describes the inserts **32** and **34** as being molded (col. 3, line 37); furthermore, there is a spine insert **38**, which they describe as being molded from a thermoplastic polymer (col. 2, lines 10-12). It is clear to the Examiner that they front panel inserts are also molded from a thermoplastic polymer.

Alternatively, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the inserts out of the same thermoplastic polymer as the book binder. The motivation for doing so would have been to save money by using the same material to make both the customizable inserts and the book binder.

With regard to claim 31, the inserts are bound to the front cover panel by various methods, including gluing, which reads on applicants' claimed adhering, heat-sealed, which reads on applicants' claimed welding, or press-fitted (col. 2, lines 2-27). The inserts are bound to the front cover panel at the side opposite the indicia.

9. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello (4,294,469) as applied to claim 37, in view of Peterson et al. (3,190,678).

Errichiello render obvious all of the limitations of applicants' claim 37 in section 10 above; however they fail to disclose that the flexible plastic material of applicants' image sheet and member are formed of polyvinyl chloride.

Peterson et al. disclose book binders, including covering material comprised of thermoplastic polymers, such as polyvinyl chloride (col. 1, lines 14-16).

Since Errichiello and Peterson et al. are both drawn to thermoplastic polymers for book binders; it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the thermoplastic polyvinyl chloride polymer of Peterson et al. for the thermoplastic polymer of Errichiello. The results of which would have been predictable to one having ordinary skill. The motivation to use polyvinyl chloride is that it is a ubiquitous thermoplastic that is well known for its chemical resistance.

10. Claims 32, 33, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello (4,294,469) as applied to claims 29 and 37, in view of Miyamoto et al. (4,460,637).

Errichiello renders obvious all of the limitations of applicants' claims 29 and 37 in section 10 above; however, they fail to disclose that there is an ink receptive coating on the inserts.

Miyamoto et al. disclose that it is known to place ink receptive layers on thermoplastic support materials, including polyvinyl chloride (col. 6, lines 47-63).

Since Errichiello and Miyamoto et al. are both drawn to thermoplastic substrates; it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the ink-receptive layers of Miyamoto et al. on the thermoplastic inserts of Errichiello. The results of which would have been predictable to one having ordinary skill. The motivation for doing so can be found at col. 1, lines 5-11 of Miyamoto et al. where they state that their recording sheet has high density and bright colors for the recorded images and also a high rate of ink absorption with a minimum of ink feathering.

With specific regard to claim 33, any surface will intrinsically have a texture. The surface of the support material of Miyamoto et al. and Errichiello will intrinsically possess a texture.

11. Claims 34 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello (4,294,469) as applied to claims 29 and 37, in view of Reed et al. (3,297,341).

Errichiello renders obvious all of the limitations of applicants' claims 27 and 37 in section 10 above; however, they fail to disclose a transparent laminate sheet overlaying said image sheet.

Reed et al. disclose a book protector, which may be a transparent plastic film (col. 2, lines 60-67). The film may have pressure sensitive adhesive on side thereof that

allows it to be adhered to a book cover (col. 1, line 65 to col. 2, line 6), and hence reads on applicants' transparent laminate sheet.

Since Errichiello and Reed et al. are both drawn to books and book covers; it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the book protector of Reed et al. with the book binders of Errichiello. The results of such a combination would have been predictable; further, each of the elements would have performed the same in combination as they had separately. The motivation behind using the book protector is to protect the cover panel and inserts.

12. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello (4,294,469) as applied to claims 29, in view of Reed et al. (3,297,341), as applied to claim 34, and further in view of Peterson et al. (3,190,678).

Errichiello in view of Reed et al. render obvious all of the limitations of applicants' claim 34 in section 13 above. The Examiner has already rendered obvious that the cover panel and inserts would be formed on a thermoplastic polymer (see section 10 above); however, Errichiello in view of Reed et al. fail to disclose that the image sheet is formed of polyvinyl chloride.

Peterson et al. disclose book binders, including covering material comprised of thermoplastic polymers, such as polyvinyl chloride (col. 1, lines 14-16).

Since Errichiello in view of Reed et al. and Peterson et al. are drawn to thermoplastic polymers for book binders; it would have been obvious to one having

ordinary skill in the art at the time the invention was made to substitute the thermoplastic polyvinyl chloride polymer of Peterson et al. for the thermoplastic polymer of Errichiello. The results of which would have been predictable to one having ordinary skill. The motivation to use polyvinyl chloride is that it is a ubiquitous thermoplastic that is well known for its chemical resistance.

Response to Arguments

13. Applicant's arguments, see Remarks, filed 07/27/2009, with respect to the objections to claims 30, 40, and 43, the rejection of claim 38 under 35 USC 112, first paragraph, and the rejection of claims 31, 33, and 43 under 35 USC 112, second paragraph have been fully considered and are persuasive. The objections/rejections have been withdrawn.

14. Applicant's arguments filed 07/27/2009 have been fully considered but they are not persuasive.

Applicants argue that claim 39 is supported since the image sheet and the member may each be formed of polyvinyl chloride or plastic.

The Examiner disagrees and notes that just because the specification supports the image sheet and the member both being polyvinyl chloride or plastic does not necessarily support the image sheet and the member being **broadly** being the same material. The two specific embodiments of polyvinyl chloride or plastic do not support the broad limitation of any same material.

Applicants argue that the claim 33 is clear at least from pg. 7, line 32 to pg. 8, line 12.

The Examiner agrees and has withdrawn the rejection.

Applicants argue that the cover part or member of Errichiello is not indentable as claimed.

The Examiner notes that there is no indication in applicants' claims at what temperature and pressure condition that applicants' cover part is to be "indentable," and therefore the Examiner deems the cover part indentable because as a thermoplastic polymer it is inherently indentable, e.g. above its glass transition temperature.

Applicants argue that the Examiner has not taught that the image is comprised of a printed ink.

This is a new limitation and the Examiner has adjusted his rejection accordingly. The Examiner notes that the printing of ink is ubiquitous and known to those of ordinary skill in the art.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is (571)270-3467. The examiner can normally be reached on M-Th 10am-8pm est. (Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Ruthkosky can be reached on 571-272-1291. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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